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JUL 12 2004

OFFICE OF PETITIONS

In re Application of :
Yeo :
Application No. 10/692,867 : ON PETITION
Filed: October 23, 2003 :
Attorney Docket No. 70021123-1 :

This decision concerns the May 10, 2004 petition under 37 CFR 1.47(b).

The petition is **DISMISSED**.

The application was filed with an unsigned declaration. On January 23, 2004, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, setting forth an extendable 2-month non-statutory reply period. The instant petition then followed, accompanied by a request for a 2-month extension of time and an authorization to charge the \$420 extension-of-time fee to Deposit Account No. 50-1078.

The petition asserts that the sole inventor, Chiau Woon Yeo ("Yeo"), refuses to sign the application papers and requests that Yeo's former employer Agilent Technologies, Inc. ("Agilent Technologies") be allowed to file the application on behalf of, and as agent for, Yeo.

Under 37 CFR 1.47(b), Agilent Technologies may do so, provided that:

- (1) Agilent Technologies has a demonstrated proprietary interest in the instant claimed invention;¹
- (2) If item (1) is met, the oath/declaration is properly executed by an officer of Agilent Technologies, or one specifically authorized by Agilent Technologies to sign the oath/declaration on its behalf;

¹ MPEP 409.03(f) (Rev. 2, May 2004).

- (3) The petition includes a statement of facts by those with firsthand knowledge of the facts recited therein, establishing that Yeo refused to sign the application oath/declaration despite the *bona fide* attempt made to present to him a copy of the entire application (specification including claims; drawings);²
- (4) The petition includes a statement that a filing date for the application is necessary to preserve the rights of the parties or to prevent irreparable damage;³
- (5) The petition includes Yeo's last known address;⁴ and
- (6) The petition includes the petition fee set forth in 37 CFR 1.17(h) (currently \$130).

The requirements in items (2)-(6) are considered met.

As discussed below, the petition lacks item (1).

To establish Agilent Technologies's proprietary interest in this application, the petition encloses a copy of Agilent Technologies's "Invention Disclosure" form signed by Yeo in 2002. The invention is identified in this form as "Absolute encoding using less photodiode/codewheel tracks" which appears similar to the invention claimed in the instant application. This form contains a "Contractual aspects" component, requesting provision of information if the invention was not made by Yeo in the course of his employment by Agilent Technologies. This component was left blank.

While the Invention Disclosure form may indicate that Yeo conceived or reduced to practice the instant claimed invention during his employment by Agilent Technologies, this form, without more,⁵ is inadequate for establishing that Yeo has assigned, or agreed to assign, his entire rights in the instant claimed invention to Agilent Technologies, or that Agilent Technologies otherwise has sufficient proprietary interest in this invention to justify its filing of this application.⁶

² MPEP 409.03(d) (Rev. 2, May 2004).

³ MPEP 409.03(g) (Rev. 2, May 2004).

⁴ MPEP 409.03(e) (Rev. 2, May 2004).

⁵ E.g., an employment contract signed by Yeo agreeing to assign, to Agilent Technologies, the entire rights of all inventions made by him while employed by Agilent Technologies.

⁶ E.g., an appropriate legal memorandum to the effect that a court of competent jurisdiction (Federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to Sterling . . . The facts in support . . . should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. See MPEP 409.03(f) (Rev. 2, May 2004).

In view of the above, the Office is unable to conclude that the requirement of item (1) is met. The petition is thus dismissed.

As authorized in the petition, the \$130 petition fee and the \$130 surcharge for lacking an acceptable oath/declaration upon filing of the application have been charged to Deposit Account No. 50-1078.

A renewed §1.47(b) petition (no fee) must be filed within **TWO MONTHS** of the mailing date of this decision,⁷ and be accompanied by an oath/declaration properly signed by Yeo, or, sufficient evidence that Agilent Technologies owns the entire interest in the instant claimed invention or otherwise has sufficient proprietary interest in the invention to justify its filing of this application.

The renewed petition(s) should be addressed to:

Mail Stop Petitions
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Telephone inquiries should be directed to the undersigned at (703) 308-0763.



RC Tang
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